

The opinion in support of the decision being entered today  
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* DAVID M. GOLDENBERG

---

Appeal 2007-0275  
Application 09/313,278  
Technology Center 2100

---

Decided: June 29, 2007

---

Before ALLEN R. MACDONALD, JEAN R. HOMERE, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the  
Examiner's rejection of claims 39-51. Claims 1-38 have been cancelled.  
We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

## THE INVENTION

The disclosed invention relates generally to the accessing of medical information and management. More particularly, the disclosed invention provides an interactive virtual doctor system using a network (Specification 1).

Independent claim 39 is illustrative:

39. A method of providing one of the group consisting of medical, veterinary, and other health care information on subjects of interest to a user, the method comprising:

- accepting an inquiry from the user;
- determining a level of service based on the user inquiry; and
- if the level of service is a first level of service:
  - determining a user sophistication based on the user inquiry;
  - searching a database at an initial level using the search request, in order to identify information requested in the user inquiry;
  - conditioning the search results based on the user sophistication;
- and
- providing the conditioned search results at the initial level to the user.

## THE REFERENCE

Douglas

US 6,039,688

Mar. 21, 2000  
(filed Oct. 31, 1997)

### THE REJECTIONS

1. Claims 39-50 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Douglas.
2. Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Douglas in view of Official Notice.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for the respective details thereof.

### STATEMENT OF LAW

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

## ANALYSIS

### Independent claim 39

We consider the Examiner's rejection of independent claim 39 as being anticipated by Douglas.

Appellant argues that Douglas does not disclose the recited step of "determining a user sophistication based on the user inquiry" (Br. 5; *see* claim 39). Appellant acknowledges that Douglas discloses a rewards feature where users earn points by "good participation in the program and by reaching certain milestones" (*see* Douglas, col. 14, ll. 42-44). However, Appellant asserts that reward points, like any other form of currency, fail to provide any indication of "user sophistication" (Br. 6). Appellant further argues that Douglas fails to disclose or suggest determining user sophistication at all (Br. 7, ¶ 4).

The Examiner disagrees. The Examiner argues that the actual number of reward points accumulated by the user [as disclosed by Douglas] does, in fact, correspond to a level of "user sophistication," as claimed (Answer 7).

In the Reply Brief, Appellant acknowledges that the claimed "sophistication" of the user is not determined solely by the educational level of the user. Nevertheless, Appellant asserts "it is clear from the instant Specification that *user sophistication relates to the degree of knowledge of the user about the specific medical condition in question*" (Reply Br. 4, ¶ 3, *emphasis added*).

Claim construction

We note that the Court of Appeals for the Federal Circuit has stated: “[w]hen the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art.” *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (internal citation omitted). Our reviewing court has further determined that “the specification is ‘the single best guide to the meaning of a disputed term,’ and that the specification ‘acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321, 75 USPQ2d 1321, 1332 (Fed. Cir. 2005) (en banc) (internal citations omitted).

This reasoning is applicable here. Thus, we agree with Appellant that a proper construction of the recited “user sophistication” relates to the degree of knowledge of the user about the specific medical condition in question as expressed in the context of the user inquiry (claim 39). We find this construction is fully consistent with the instant Specification at page 9, line 27, through page 10, line 9.

We note that Douglas discloses a reward point system where users “earn points by good participation in the program and by reaching certain milestones” (col. 14, ll. 41-44). The Examiner contends the claimed “user sophistication” can be broadly but reasonably read on the “reward points” of Douglas (*see* Answer 7, ¶ 2). We disagree. The Examiner’s argument appears to be based on the assumption that users with more reward points are inherently (i.e., necessarily) more “sophisticated” than users with fewer

reward points. We note that our reviewing court has found that “[i]nherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (internal citations omitted).

Here, we find the Examiner’s reasoning fails because two users with identical levels of “participation” (or other milestones) may have vastly different medical information needs, as pointed out by Appellant in the Brief (*see* Br. 6, ¶ 2). Indeed, Douglas discloses: “[t]he members of the wellness group may not need all the features [i.e., information] available to members of the clinical group” (col. 5, ll. 60-61). Thus, we find the sicker clinical group would likely present more sophisticated medical information inquiries than the healthier wellness group. In the alternative, two users with similar conditions of wellness (or clinical illness) may have different numbers of reward points (based upon differences in user participation), even though these users would have similar medical information needs (i.e., possessing the same level of “user sophistication”). Thus, we find that “user sophistication” (as claimed) cannot be fairly read on the reward points of Douglas because of the *imperfect correlation* between user medical information needs (i.e., “user sophistication”) and the reward points.

It appears the Examiner is reading the recited “user inquiry” on the portion of Douglas that discloses the “reward ‘apples’ icon 92 allows a user to view information [i.e., request information] on the rewards point system and how it works” (col. 14, ll. 38-41, Fig. 9). Nevertheless, in light of the above discussion, we find nothing in Douglas that fairly discloses where

*user sophistication is determined based on a user inquiry*, as required to meet the disputed language of the claim. Therefore, we find the Examiner has failed to establish a prima facie case of anticipation for claim 39. Accordingly, we reverse the Examiner's rejection of independent claim 39 as being anticipated by Douglas.

#### Dependent claims 40-51

Because we have reversed the Examiner's rejection of the sole independent claim (claim 39), we will not sustain the Examiner's rejection of any dependent claims under appeal. Therefore, we reverse the Examiner's rejection of dependent claims 40-50 as being anticipated by Douglas. Likewise, we reverse the Examiner's rejection of dependent claim 51 as being unpatentable over Douglas in view of Official Notice.

#### OTHER ISSUE

We note that the question of whether it would have been obvious to “[determine] a user sophistication based on the user inquiry” is not before us (claim 39). However, we direct the Examiner's attention to U.S. Patent 5,287,448 to Nicol (1994) that teaches a method and apparatus for providing help information to computer users. Nicol teaches a method of providing messages that are context sensitive (col. 2, ll. 32-33). In particular, Nicol discloses that context elements can be the *type of help requested by the user* as well as the *user's level of sophistication* (col. 2, ll. 37-41). We conclude that Douglas at least suggests a need for different levels of medical information to be provided to different categories of users (*see* Douglas at col. 5, ll. 60-61: “The members of the wellness group may not need all the

Appeal 2007-0275  
Application 09/313,278

features available to members of the clinical group”). Therefore, we leave it to the Examiner to consider whether at least claim 39 would have been obvious to a person of ordinary skill in the art at the time of the invention over Douglas in view of Nicol, or any other prior art references available to the Examiner.

### DECISION

In summary, we will not sustain the Examiner’s rejection of any claims under appeal. Therefore, the decision of the Examiner rejecting claims 39-51 is reversed.

REVERSED

gw

HELLER EHRMAN LLP  
1717 RHODE ISLAND AVE, NW  
WASHINGTON, DC 20036-3001